



DOCKET NO: 241856US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
HIROYUKI MORO : EXAMINER: LANE, JOHN A  
SERIAL NO: 10/647,291 :  
RCE FILED: MARCH 20 2006 : GROUP ART UNIT: 2185  
FOR: MEMORY CARD :  
AUTHENTICATION SYSTEM,  
CAPACITY SWITCHING-TYPE  
MEMORY CARD HOST DEVICE,  
CAPACITY SWITCHING-TYPE  
MEMORY CARD, STORAGE CAPACITY  
SETTING METHOD, AND STORAGE  
CAPACITY SETTING PROGRAM

PETITION UNDER 37 C.F.R. § 1.181

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

This Petition is in response to the Official Communication mailed on April 26, 2006.

This Petition under 37 C.F.R. §1.181 requests that the requirement under 37 C.F.R. §1.105 be withdrawn as unsupported by the rules and unreasonably burdensome.

In the outstanding Official Communication, the following items were required: (1) identification of all independent claim limitations (claims 1, 2, 7, 14, 15, 21 and 22) corresponding to prior art elements in the background documentation;<sup>1</sup> (2) identification of all present independent claim limitations corresponding to prior art elements in the IDS

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<sup>1</sup> Outstanding Official Communication, page 2, item 2, paragraph beginning "In the present disclosure..."

documentation filed December 12, 2005, March 20, 2006 and August 26, 2003;<sup>2</sup> (3) support noting correlation and identification of what structure, material, or acts set forth in the specification would be capable of carrying out the function recited in the step plus function limitations of independent claims 14 and 15;<sup>3</sup> (4) All claim language that does not have antecedent basis in the descriptive portion of the specification;<sup>4</sup> (5) Identify claim language added to any present claims on amendment and any new claims and identify support for each claim limitation (including structural and functional language linking claim elements, e.g. coupled to, responsive to) by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s) and the corresponding limitation;<sup>5</sup> (6) in the event the foreign priority application is needed to support any claim limitation, applicant must identify such limitations and corresponding translated English language text in the priority application;<sup>6</sup> and (7) clearly point out the patentable novelty the claims present in view of the state of the art disclosed by the references cited or the objections made, a showing of how the amendments avoid such references or objections must also be present.<sup>7</sup>

A brief recapitulation of the events of the present case may be helpful. On September 27, 2005 the Examiner issued a first office action which was a notice of allowance. No claims had been amended. On November 3, 2005 an IDS was filed which included a number of references cited for the first time in the counterpart Japanese application. On December 12, 2005 the issue and publication fees were paid. On January 19, 2006 the Examiner responded to the IDS filed on November 3, 2005 with a request for information under §1.105.

Specifically, the Examiner stated “A large number of English language Abstracts (11) and a translated Japanese Office action have been presented to the examiner after allowance.

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<sup>2</sup> Outstanding Official Communication, page 3, item 2., paragraph beginning “Additionally, the examiner requests...”

<sup>3</sup> outstanding Official Communication, page 3, paragraph beginning “The examiner also requests...”.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

<sup>6</sup> outstanding Official Communication, page 4, lines 1-5.

<sup>7</sup> outstanding Official Communication, page 4, second paragraph, beginning “when responding...”

Since the inventor, attorney of record and/or the assignee are most familiar with the claimed invention and the submitted prior art, the examiner requests a detailed discussion of which, if any, independent claim limitations correspond to or are anticipated by prior art features found in the IDS documentation.”

On March 20, 2006, the Applicants filed a Petition for Withdrawal of Application from Issue Under 37 C.F.R. 1.313 and a Request for Continued Examination. In response the Examiner issued the outstanding Official Communication on April 26, 2006.

Turning now to the rule governing requests for information, 37 C.F.R. §1.105 states, in part,

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example...

(viii) Technical information known to applicant. Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items...

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

- (i) A requirement for factual information;
- (ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or
- (iii) Stipulations as to facts with which the applicant may agree or disagree.

Further M.P.E.P. §704.11 states that,

[i]nformation which may be required under 37 C.F.R. §1.105 is that information reasonably necessary to properly examine or treat a matter in a pending or abandoned application filed under 35 U.S.C. 111...[t]here must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.

As can be seen in the sections cited above, the purpose of 37 C.F.R. §1.105 is to allow the Examiner to request factual information which would be reasonably necessary to properly examine or treat a matter; factual information being reasonably necessary, for example, when the Examiner needs assistance finding prior art or resolving an issue arising from the results of a search or analysis of the application file.

For instance, all of the examples listed in 37 C.F.R. §1.105 and M.P.E.P. §704.11(a) are directed to requests for factual information regarding the filed application.

Turning now to the specific items requested in the outstanding Office Action.

With regard to item **(1)** the outstanding Communication requested identification of all independent claim limitations (claims 1, 2, 7, 14, 15, 21 and 22) corresponding to prior art elements in the background documentation. This item requires the Applicant to do more than relay facts as is required by §1.105. Instead, this requirement forces the Applicant to make a legal conclusion which is the domain of the Examiner.

With regard to item **(2)** the outstanding Communication requested identification of all present independent claim limitations corresponding to prior art elements in the IDS documentation filed December 12, 2005, March 20, 2006 and August 26, 2003. As with item **(1)** discussed above, this item requires the Applicant to make a legal conclusion which goes beyond the requirements of §1.105.

With regard to item **(3)** the outstanding Communication requested support noting correlation and identification of what structure, material, or acts set forth in the specification would be capable of carrying out the function recited in the step plus function limitations of

independent claims 14 and 15. Claims 14 and 15 have no step plus function limitations so this requirement does not apply.<sup>8</sup>

With regard to item (4) the outstanding Communication requested all claim language that does not have antecedent basis in the descriptive portion of the specification. This item requires the Applicant to make a legal conclusion which goes beyond the requirements of §1.105. Instead of merely requiring the Applicant to relay facts, this item requires the Applicant to conclude that specific claim language does or does not have antecedent basis. This requirement is within the domain of the Examiner and is contrary to the provisions of §1.105.

With regard to item (5) the outstanding Communication requested claim language added to any present claims on amendment and any new claims be identified and that support for each claim limitation (including structural and functional language linking claim elements, e.g. coupled to, responsive to) be identified by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s) and the corresponding limitation. However, no amendments have been made in the present case, thus no support for amendments can be provided as is required by item (5).

With regard to item (6) the outstanding Communication requested that in the event that a foreign priority application is needed to support any claim limitation, applicant must identify such limitations and corresponding translated English language text in the priority application. This item requires the Applicant to make a legal conclusion which goes beyond the requirements of §1.105. Instead of merely requiring the Applicant to relay facts, this item requires the Applicant to conclude that specific claim language is supported only by the

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<sup>8</sup> See M.P.E.P. §2181(I), "Also, a statement of function appearing only in the claim preamble is generally insufficient to invoke 35 U.S.C. 112, sixth paragraph" and "the claim limitations must use the phrase "means for" or "step for"" to be interpreted to invoke 35 U.S.C. 112, sixth paragraph.

foreign priority application. This requirement is within the domain of the Examiner and is contrary to the provisions of §1.105.

With regard to item (7) the outstanding Communication requested that the Applicant clearly point out the patentable novelty the claims present in view of the cited or the objections made, a showing of how the amendments avoid such references or objections must also be present. This item requires the Applicant to make a legal conclusion which goes beyond the requirements of §1.105. Instead of merely requiring the Applicant to relay facts, this item requires the Applicant to make conclusions about how the state of the art disclosed by the references cited by the Examiner, which is the domain of the Examiner and not the Applicant.

Therefore it is submitted that the scope of the outstanding Request for Information under §1.105 is not narrowly defined and the Examiner did not have a reasonable basis for requiring the non-factual information noted in the above discussion.

Accordingly, it is respectfully submitted that this Petition under 37 C.F.R. §1.181 be granted and that the Examiner withdraw his requirement for information under §1.105.

Respectfully submitted,

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